

REMARKS

Claim 48 is canceled without prejudice, and therefore claims 22 to 47 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph three (3) of the Final Office Action, claims 47 and 48 were objected to as to proper antecedent basis under 37 C.F.R. 1.75(d)(1).

As for claim 47, in view of the fact that the specification specifically uses the phrase “check result” (see, e.g., Substitute Specification at page 15, line 16), it is respectfully submitted that the objection is simply not understood and that there is no basis for the objection. It is therefore respectfully requested that the objection to claim 47 be withdrawn.

As to claim 48, while the objection may not be agreed with, to facilitate matters, it is canceled without prejudice.

With respect to paragraph five (5) of the Final Office Action, claims 47 and 48 were rejected as to the written description requirement under 35 U.S.C. §112, ¶1.

To reject an application based on the written description requirement, the Office has the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). Moreover, the specification as originally filed must, of course, provide a statutorily sufficient written description of the claimed subject matter to a person having ordinary skill. It does not matter, however, exactly how this is done so long as the written description requirement is satisfied. To determine whether the written description requirement is satisfied, the specification as a whole must be considered, and, in this regard, the Federal Circuit has made clear that the “claimed subject matter need not be described *in haec verba*” in the application for it to satisfy the written description

U.S. Pat. App. Ser. No. 09/944,915
Attorney Docket No. 10191/2007
Reply to Final Office Action of August 31, 2007

requirement. See In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (citing In re Smith, 481 F.2d 910, 914, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973)).

As to claim 47, it now provides that “the check result is not used to process the first data.” (emphasis added). The check result referred in claim 47 includes a positive check result that is stored in a storage and is transmitted to the first processor for the use of processing the first data. (See Substitute Specification at page. 15, lines 16-18 (“the check process is terminated and a positive check result for a license to use the first data in first processor 3 and a conclusion of the check process are stored in nonvolatile memory 5.”)). If the check result indicates that the first data in first processor must not be used, a prohibition against use of the first data is transmitted to the first processor. (See id. at page14, lines 30-34). Then, at a final step, the first data in the first processor is deleted (see id. at page 14, line 35 to page 15, line 1), and therefore, the check result is not used to process the first data.

Accordingly, the substitute specification plainly provides a proper written description (especially for a person of ordinary skill in the art) as to claim 47.

As to claim 48, while the rejection may not be agreed with, to facilitate matters, claim 48 is canceled.

With respect to paragraph seven (7), claims 22 to 24, 26 to 28, 31 to 34, 36, and 39 to 45 were rejected under 35 U.S.C. § 102(e) as anticipated by Peinado et al. U.S. Patent No. 7,051,005.

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)).

While the rejections may not be agreed with, to facilitate matters, claims 22 and 41 to 44 have been rewritten so that each of independent claims 22, 24, 34, and 41 to 44 provide for “transmitting a check result to the first processor” or the first processor “receiving a check result from the second processor.” (emphasis added).

As to the Examiner’s Response to Arguments (see paragraph fourteen (14) of the Office Action), Applicant respectfully submits that the Peinado reference does not identically disclose (nor even suggest) the feature of transmitting a check result to the first processor, as in claims 22, 24, 34, and 41 to 44. The Final Office Action asserts that in Peinado, “information sent from the license server tells the first processor that i[t] has

permission to process the data using the information,” and, “[t]he refusal to send this information is an indication that the check has failed and the first processor does not have permission.”

Even if this were so (which is not conceded), Peinado does not identically disclose the feature of “transmitting a check result to the first processor” or “receiving the check result from the second processor,” as provided for in the context of the claimed subject matter. The check result as presented in claims is an indicator affirmatively transmitted from the second processor to the first processor. When a positive check result is transmitted to the first processor, the first processor has permission to process the first data. (See Substitute Specification at page 15, lines 15-23). When the conclusion from the check process indicates that the first processor must not be used, an indicator of “prohibition against use of the first data is transmitted to the first processor by the second processor.” (See id. at page 14, lines 30-34). After receiving the prohibition from the second processor, the first processor may take the action to delete the first data. (See id., page 14, line 35–page 15, line 1). In contrast, the mere refusal to send a license in Peinado does not disclose the affirmative act of transmitting an indicative check result from the second processor to the first processor because without an indicator that the check result is a prohibition, the first processor is in fact waiting for a check result and is unable to take any action such as deleting the first data by the first processor.

Accordingly, claims 22, 24, 34, and 41 to 44, as presented, are not anticipated by the Peinado reference.

Claims 23, 25 to 33, 35 to 40, and 45 to 48, as presented, depend from claims 22, 24, 34, or 41 to 44, and are therefore allowable for the same reasons.

It is therefore respectfully requested that the anticipation rejections be withdrawn.

With respect to paragraph nine (9), claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado as applied to claim 22 in view of Okada, U.S. Patent No. 6,704,872.

It is respectfully submitted that even if it were proper to modify the Peinado reference as suggested by the Final Office Action (which is not conceded), the Okada reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claim 25 ultimately depends. Accordingly,

U.S. Pat. App. Ser. No. 09/944,915
Attorney Docket No. 10191/2007
Reply to Final Office Action of August 31, 2007

claim 25 is allowable for at least same reasons as claim 22, as presented, since the Okada reference does not cure the critical deficiencies of the Peinado reference.

With respect to paragraph ten (10), claims 29, 30 and 47 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado.

It is respectfully submitted that claims 29, 30 and 47 ultimately depend on claim 22. The Peinado reference has critical deficiencies (as explained above) with respect to claim 22 as presented. Accordingly, claims 29, 30 and 47 are allowable for at least same reasons as claim 22, as presented.

With respect to paragraph eleven (11), claim 35 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado as applied to claim 22 in view of Gurr, U.S. Patent No. 4,264,960.

It is respectfully submitted that even if it were proper to modify the Peinado reference as suggested by the Final Office Action (which is not conceded), the Gurr reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claim 35 ultimately depends. Accordingly, claim 35 is allowable for at least same reasons as claim 22, as presented, since the Gurr reference does not cure the critical deficiencies of the Peinado reference.

With respect to paragraph twelve (12), claims 37 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado as applied to claim 22 in view of Coley, U.S. Patent No. 5,790,664.

It is respectfully submitted that even if it were proper to modify the Peinado reference as suggested by the Final Office Action (which is not conceded), the Coley reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claims 37 and 46 ultimately depend. Accordingly, claims 37 and 46 are allowable for at least same reasons as claim 22, as presented, since the Gurr reference does not cure the critical deficiencies of the Peinado reference.

With respect to paragraph thirteen (13), claim 38 was rejected under 35 U.S.C. § 103(a) as unpatentable over Peinado as applied to claim 22 in view of Flick, U.S. Patent No. 6,140,939.

It is respectfully submitted that even if it were proper to modify the Peinado reference as suggested by the Final Office Action (which is not conceded), the Flick

U.S. Pat. App. Ser. No. 09/944,915
Attorney Docket No. 10191/2007
Reply to Final Office Action of August 31, 2007

reference does not cure the critical deficiencies of the Peinado reference (as explained above) with respect to claim 22 as presented, from which claim 38 ultimately depends. Accordingly, claim 38 is allowable for at least same reasons as claim 22, as presented, since the Flick reference does not cure the critical deficiencies of the Peinado reference.

Withdrawal of these obviousness rejections is therefore respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Dated: 10/29/07

Respectfully submitted,

By:

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

*By G.A. Messina
33,865
Aaron C. Deitch*

CUSTOMER NO. 26646

1412627